

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed February 4, 2009. Through this response, claim 1 has been amended, claims 62-63 have been canceled without prejudice, waiver, or disclaimer, and claims 64 and 65 have been added consistent in scope to the pending claims 1, 3, 7, 10-39 and fully supported at least on pages 8-9 of the specification as originally filed. Reconsideration and allowance of the application and pending claims 1, 3, 7, 10-39, 64, and 65 are respectfully requested.

#### **I. Restriction Requirement**

The non-final Office Action (page 3) alleges that claims 62 and 63 are directed to an invention that is independent or distinct from the invention originally claimed. Applicants have canceled claims 62 and 63 without prejudice, waiver, or disclaimer.

#### **II. Claim Rejections - 35 U.S.C. § 103(a)**

##### **A. Rejection of Claims 1, 3, 7 and 10-39**

Claims 1, 3, 7 and 10-39 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hartman et al.* ("*Hartman*," U.S. Pat. No. 5,960,411) in view of *Beck et al.* ("*Beck*," U.S. Pat. No. 6,138,139). Applicants respectfully submit that the rejection has been rendered moot. In addition, Applicants respectfully submit that claims 1, 3, 7, and 10-39 are allowable over *Hartman* in view of *Beck*.

##### **B. Discussion of the Rejection**

The M.P.E.P. § 2100-116 states:

Office policy is to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obvi-

ousness under 35 U.S.C. 103. . . the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

In the present case, it is respectfully submitted that a *prima facie* case for obviousness is not established using the cited art of record.

### Independent Claim 1

Claim 1 recites (with emphasis added):

1. A method in a media service system for transaction configuration, the method comprising the steps of:
  - receiving by an administrator a global set of preconfigured transaction configuration options;
  - enabling selection by the administrator of a client set from the global set, the client set corresponding to a subset of the global set;
  - enabling by an administrator presentation of the client set to the exclusion of one or more of the preconfigured transaction configuration options of the global set to a user, one or more of the preconfigured transaction configuration options of the client set capable of being deactivated from participation in future purchase transactions;**
  - enabling by the administrator selection by the user of at least one transaction configuration option from among a plurality of transaction configuration options of the client set presented to the user, wherein each transaction configuration option of the client set defines one or more actions that take place during the purchase of an item or service when the user utilizes at least one client device to complete a purchase;
  - implementing at least one transaction process responsive to the user indicating a desire to purchase an item or service utilizing the at least one client device from among a plurality of transaction processes comprising pre-configured transaction processes and **user defined transaction processes**, wherein at least one user defined transaction process comprises the user selected at least one transaction configuration option,
  - wherein at least one transaction configuration option comprises a single execution transaction option that enables the user to initiate and complete an entire purchase in one execution.

Applicants respectfully submit that a *prima facie* case for obviousness is not established using *Hartman* in view of *Beck*. The non-final Office Action (page 5) refers to column 14, lines 45-49 and column 16, lines 25-37 of *Beck* for administrator enabling features of claim 1, the recited sections provide as follows:

In one embodiment, it may be part of a system administrator's tool kit.

Window 133 contains interactive options directed at various categories and functions. For example, a new client section 135 contains interactive options related to adding a new client to the active customer base of the enterprise.

New order section 139 in this example contains various options adapted to facilitate placing orders. The options as illustrated herein include, but are not limited to, I-phone, call back, promotional models, video presentations, an on-line viewer, and an order wizard. Interaction is the same as was stated with regards to section 137. For example, selecting promotional models, accesses a database containing the current promotional information and features of products which may be viewed interactively by the client using an on-line viewer offered as one of the functional options (tool). The options presented in the New Orders section may also be customized according to client identity, demographics, transaction

history, and enterprise rules.

Nothing in the cited sections from *Beck* above discloses, teaches, or suggests at least the above-emphasized claim features. It is noted that the tools to provide customization are not user configurable, nor is there any indication that fewer than the initially configured options can be presented to the user. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Because independent claim 1 is allowable over *Hartman* in view of *Beck*, dependent claims 3, 7, and 10-39 are allowable as a matter of law for at least the reason that the dependent claims 3, 7, and 10-39 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In addition, Applicants respectfully submit that one or more of the dependent claims are allowable on distinct and separate grounds, and hence the rejections should be withdrawn. For instance, with regard to claim 7, *Hartman* in view of *Beck* fails to disclose, teach, or suggest “wherein the user is enabled to make at least one selection of a plurality of particular transaction configuration options included in at least one pre-configured transaction process, the at least one selection causing at least one plurality of particular transaction configuration options to be removed from the pre-configured transaction process.” The Office Action (page 7) refers to col. 16, lines 38-47 of *Beck* for alleged disclosure of the claim 7 features. Applicants respectfully disagree. There is nothing in this section of *Beck* that discloses or suggests **removal**. The absence of features is not the same as removal.

As another example, Applicants respectfully submit that *Hartman* in view of *Beck* fails to disclose, teach, or suggest at least “wherein the at least one transaction configuration option is a PIN option and wherein the implementing step implements the transaction process responsive to at least one selection of the PIN option requiring a correct PIN entry to complete a transaction.” The Office Action (page 6) refers to col. 5, lines 24-26 of *Hartman*. A “login” is not necessarily the same as **a PIN entry**.

In summary, it is Applicants’ position that a *prima facie* for obviousness has not been made against Applicants’ claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Hartman* in view of *Beck* and that the rejection of these claims should be withdrawn.

### III. New Claims

As identified above, claims 64 and 65 have been added into the application through this response. Applicants respectfully submit that claim 64 (and by

incorporation of the same features in dependent claim 65) are allowable for at least the reason that *Hartman* in view of *Beck* fails to disclose, teach, or suggest at least “a ***headend server*** configured to present an administrator interface, the interface configured to: enable selection by the administrator of a user configurable client set from the global set, the ***user configurable client set*** corresponding to a subset of the global set; and ***enable by an administrator presentation of the client set, to the exclusion of one or more of the preconfigured transaction configuration options of the global set***, to a user, one or more of the preconfigured transaction configuration options of the client set capable of being deactivated from participation in future purchase transactions.” For at least this reason, Applicants respectfully request allowance of claims 63 and 64.

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at the below number.

Respectfully submitted,

/David Rodack/

David Rodack  
Registration No. 47,034

Merchant & Gould  
P.O. Box 2903  
Minneapolis, Minnesota 55402-9946  
Telephone: 404.954.5066